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| 09/915,824 | 07/26/2001 | Geoffrey B. Rhoads | EWG-116 US | 7918 |

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EXAMINER

SWEARINGEN, JEFFREY R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2145

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,824

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. Examiner advises Applicant to review communication from the Office mailed on 13 March 2003.
2. Applicant claims priority to provisional application no. 60/220,945. Applicant states that the filing date for provisional application no. 60/220,945 is 26 June 2000. PTO records show that the filing date for provisional application no. 60/220,945 is 26 July 2000.
3. The effective filing date for this application is 26 July 2000.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 2, items 201 and 205.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 3, item 303; Figure 4, item 401. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "402" has been used to designate both an originating device and a router server. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Claim Objections

8. Claim 4 objected to because of the following informalities: The claim has two periods.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. **Claims 1, 12-13** rejected under 35 U.S.C. 102(a) as being anticipated by Privacy 2000: In Web We Trust? (Tynan, Daniel. PC World, June 2000. pp. 103-108.).

11. Regarding **claim 1**, Privacy 2000 discloses a method including *a first web server storing a file that includes collateral data, a second web server that has stored therein a data base of users and associated interest profiles, a third web server that stores web pages of interest to users with a particular interest profile, the steps of accessing said file and reading the collateral data to obtain the URL of said second web server, interrogating said database to find the interest profile of the particular user who accessed said file, and accessing a web page having information pertinent to the particular user to provide information to said user.* [Privacy 2000 discloses a web page which stores a cookie on the user's hard disk [file including collateral data]. The cookie sends information back to a server that keeps track of the user's movements [interrogating said database to find the interest profile of the particular user who accessed said file] and returns a banner ad [accessing a web page having information pertinent to the particular user to provide information to said user]. See Privacy 2000, "Double Trouble".] By this rationale **claim 1** is rejected.

12. Regarding **claim 12**, Privacy 2000 is applied as in claim 1. Privacy 2000 further discloses using Global Unique Identifiers to store information. ["...each cookie contains a globally unique identifier (GUID), which lets the ad server track your movements without identifying your actual name or e-mail

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address." See Privacy 2000, "Double Trouble", paragraph 2 (page 4 of included reference).] By this rationale **claim 12** is rejected.

13. Regarding **claim 13**, the limitations of this claim are substantially the same as those in claim 12. Therefore the rationale used to reject claim 12 is applied to reject claim 13. By this rationale **claim 13** is rejected.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 2-6, 8, 14-15** rejected under 35 U.S.C. 103(a) as being unpatentable over Fairchild et al. (U.S. Patent No. 6,728,760, hereafter referred to as Fairchild) and Tack-don et al. (U.S. Pub. No. 2001/0023457, hereafter referred to as Tack-don).

16. Regarding **claim 2**, Fairchild discloses using a server with a personal assistant (*data base with user characteristics*) and forwarding media (*object*) that matches the personal assistant (PA) to the user by way of an image with a watermark providing information (*keywords*). [See Fairchild, column 8, lines 43-58.] Fairchild fails to disclose using a camera to read an image.

17. However, Tack-don discloses using a camera to read an image into a server (*using a camera to read an image containing a watermark*). [See Tack-don, page 2, paragraph 0028. See Tack-don, page 3, paragraph 0034].

18. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Fairchild and Tack-don for the purpose of providing a computer user with access to media items whenever the media item relates to a user's preferences. [See Fairchild, column 4, lines 43-46]. Tack-don gives motivation for the combination by stating that a user will receive advertising services (information) based upon code information in a code image. [See Tack-don, page 2,

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paragraph 0031. See Tack-don, page 2, paragraph 0015. See Tack-don, page 3, paragraph 0032.] By this rationale **claim 2** is rejected.

19. Regarding **claim 3**, Fairchild and Tack-don are applied as in claim 2. Tack-don further discloses a user database containing information on users registered (*user characteristics*). [See Tack-don, page 2, paragraph 0025.] By this rationale **claim 3** is rejected.

20. Regarding **claim 4**, Fairchild and Tack-don are applied as in claim 2. Fairchild further discloses sending a message to the user that a media object is similar to the user's preferences (*selects one object from said collection of objects and informs said user of said selection*). [See Fairchild, column 8, lines 54-61.] By this rationale **claim 4** is rejected.

21. Regarding **claim 5**, the limitations of this claim are substantially the same as the limitations of claim 2. Fairchild further discloses accessing media (*a web page having information pertinent to the particular user to provide information to said user*). [See Fairchild, column 8, lines 58-61.] By this rationale **claim 5** is rejected.

22. Regarding **claim 6**, Fairchild and Tack-don are applied as in claim 5. Tack-don further discloses a user database containing information on users registered (*user characteristics*). [See Tack-don, page 2, paragraph 0025.] By this rationale **claim 6** is rejected.

23. Regarding **claim 7**, Fairchild and Tack-don are applied as in claim 5. Fairchild discloses accessing media based upon user preferences as in claim 5. [See Fairchild, column 8, lines 58-61.] It is Examiner's position that "accessing media" includes "accessing a web site". By this rationale **claim 7** is rejected.

24. Regarding **claim 8**, Fairchild and Tack-don are applied as in claim 5. Tack-don further discloses use of a PC camera. [See Tack-don, page 3, paragraph 0034.] By this rationale **claim 8** is rejected.

25. Regarding **claim 14**, the limitations of this claim are substantially the same as the limitations of claim 8. Therefore the rationale used to reject claim 8 is used to reject claim 14. By this rationale **claim 14** is rejected.

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26. Regarding **claim 15**, the limitations of this claim are substantially the same as the limitations of claim 5. Therefore the rationale used to reject claim 5 is used to reject claim 15. By this rationale **claim 15** is rejected.

27. Regarding **claim 16**, Fairchild and Tack-don are applied as in claim 15. Tack-don further discloses that an *electronic image can be acquired from a physical image containing a watermark*. [Tack-Don discloses that an image apparatus can obtain visual information from a physical object and decodes a code image to extract information. A code image is an image with a watermark. See Tack-don, page 3, paragraph 0034.] By this rationale **claim 16** is rejected.

28. Regarding **claim 17**, Fairchild and Tack-don are applied as in claim 15. Fairchild further discloses the use of the Internet for accessing information through the personal assistant (*database*). [See Fairchild, column 8, lines 61-64. It is Examiner's position that a dial-up connection at home is a connection to the Internet, and that connecting through the dial-up connection is using the Internet for accessing information through the personal assistant.] By this rationale **claim 17** is rejected.

29. Regarding **claim 18**, Fairchild and Tack-don are applied as in claim 15. Tack-don further discloses the computer contains a web browser. [See Tack-don, page 2, paragraph 0030.] By this rationale **claim 18** is rejected.

30. **Claims 9-11** rejected under 35 U.S.C. 103(a) as being unpatentable over Fairchild and Tack-don, and further in view of Mitchell et al. (U.S. Patent No. 6,574,672).

31. Regarding **claim 9**, Fairchild and Tack-don are applied as in claim 5. Fairchild and Tack-don fail to disclose a *camera and a data base are contained in a portable computer*.

32. However, Mitchell discloses a portable computing system which holds a camera and a database. [Mitchell discloses a wearable computer, which is portable. The portable computer can contain a database. See Mitchell, column 3, lines 41-44. See Mitchell, column 2, lines 38-48. The portable computer can contain a camera that transmits images. See Mitchell, column 4, lines 11-17.] The system may be part of a network. [See Mitchell, column 3, lines 21-27. See Mitchell, column 3, lines 50-53.]

33. It would have been obvious to one of ordinary skill in the networking art at the time of the invention to combine the teachings of Fairchild and Tack-don with the teachings of Mitchell for the

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purpose of using the system in a remote location. [See Mitchell, column 2, lines 49-53.] Fairchild gives motivation for the combination by stating that Fairchild's system can be used on a network of computers. [See Fairchild, column 6, lines 10-12.] By this rationale **claim 9** is rejected.

34. Regarding **claim 10**, Fairchild, Tack-don and Mitchell are applied as in claim 9. Fairchild further discloses the use of the Internet for accessing information through the personal assistant (*database*). [See Fairchild, column 8, lines 61-64. It is Examiner's position that a dial-up connection at home is a connection to the Internet, and that connecting through the dial-up connection is using the Internet for accessing information through the personal assistant.] By this rationale **claim 10** is rejected.

35. Regarding **claim 11**, Fairchild, Tack-don and Mitchell are applied as in claim 9. Tack-don further discloses the computer contains a web browser. [See Tack-don, page 2, paragraph 0030.] By this rationale **claim 11** is rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey R. Swearingen
Examiner

W. A. C. V. A. G. A.
Primary Examiner
Art Unit 2143

JRS